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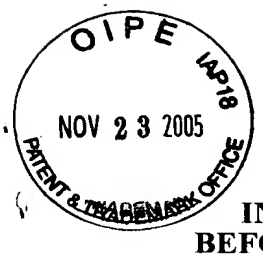


PATENT
Attorney Docket No. 211174
Client Reference No. REN 1-00-107 CIP3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

ULRICH et al.

Art Unit: 1761

Application No. 09/637,843

Examiner: C. A. Paden

Filed: August 10, 2000

For: PRODUCTS COMPRISING CORN OIL AND CORN MEAL OBTAINED FROM HIGH OIL CORN

APPELLANTS' REPLY BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Examiner's Answer, Appellants now submit their Reply Brief. Appellants stand by the remarks in their Appeal Brief and respectfully request that the following additional remarks be considered as well.

MAILING/TRANSMISSION CERTIFICATE UNDER 37 CFR 1.8 OR 1.10			
I hereby certify that this document and all accompanying documents are, on the date indicated below, being ☒ deposited with the U.S. Postal Service using "Express Mail" service in an envelope addressed in the same manner indicated on this document with Express Mail Label Number EV420397128, ☐ deposited with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed in the same manner indicated on this document, or ☐ facsimile transmitted to the U.S. Patent and Trademark Office at fax number:			
Name (Print/Type)	Jeffrey B. Burgan		
Signature	Jeffrey Burgan	*Date*	November 23, 2005

In the Examiner's Answer, the Examiner indicated in her Remarks 1-5 and 7 that she was in agreement with Applicants' Reply Brief. Accordingly, Applicants address Examiner's remaining **Remarks 6, 8, 9, and 10**.

Grounds of Rejection to be Reviewed on Appeal

The Examiner alleged in **Remark 6** of her Answer that Appellants' statement of the status of amendments after final rejection contained in the Appeal Brief was incorrect. Appellants respectfully traverse.

The Examiner's statements in her Answer appear to contradict, at least in part, her statements in the Advisory Action mailed May 23, 2005. In the Advisory Action, the Examiner stated "The claims stand rejected over Corn Chemistry in view of Morrison. The double patenting rejection and the rejection under 35 USC 103 over Ulrich have been dropped for the reasons argued by the applicant. Applicant is still required to resolve the issue relating to joint inventors." (Underlining in the original.) In her Answer (page 3) to Appellants' Appeal Brief, she stated: "The rejection of the claims under 35 USC 103 was dropped in the Advisory Action, dated May 23, leaving only a requirement for applicant to resolve the issue relating to the joint inventors."

First, the rejection over Corn Chemistry (Watson) in view of Morrison is a rejection under 35 U.S.C. § 103, and the Examiner restates the language of her rejection from the first Office Action (pages 12-13 of the Action mailed September 22, 2004) in **Remark 9** ("Grounds of Rejection") of her Answer. The Examiner apparently retained this rejection in both the final Office Action and the Advisory Action. Accordingly, while the Examiner dropped some of the rejections under § 103, she did not drop all of the rejections under § 103. If she had dropped all rejections under § 103, Appellants would have had no need to file this appeal, the Examiner should have issued a Notice of Allowance, and the Examiner would not have restated the rejection in her Answer. If the Examiner believes there are no remaining rejections under § 103, Applicants respectfully request that she promptly issue a Notice of Allowance allowing all pending claims.

Second, what the Examiner describes as the "requirement for applicant to resolve the issue relating to the joint inventors" was made in the context of a rejection of the claims under § 103 over Ulrich (U.S. Patent No. 6,723,370), see pages 2 and 3 of the final Office Action

mailed February 2, 2005. The Examiner's withdraw of the § 103 rejection over Ulrich renders moot any issue relating to joint inventors as well as any need to list Ulrich ('370) in **Remark 8** of her Answer as evidence relied upon. For these reasons and those presented in their Appeal Brief, Appellants believe no issue relating to joint inventors exists.

Response to Argument

In **Remark 10** "Response to Argument" of her Answer, the Examiner stated that she was not persuaded by Appellants' argument. Appellants, again, stand by their arguments set forth in their Appeal Brief, and provide the following remarks for the purpose of addressing specific aspects of the Examiner's Response to Argument.

First, the Examiner still fails to consider all elements of the claims when comparing the claims to the references cited. The claims recite, in part, "corn meal obtained after extraction of oil from whole high oil corn" or "corn meal obtained after extraction of oil from whole kernels of high oil corn." The Examiner invariably either omits the term "whole" or "high" when referring to corn in respect to the claimed invention. This practice by the Examiner is impermissible for the reasons set forth in Appellants' Appeal Brief. All elements of the claims must be considered.

Second, in her Response to Argument, the Examiner makes reference to a Figure 1 of Watson, and alleges the process shown therein apparently meets the requirements of the claims. Appellants respectfully traverse. There are actually two Figure "1"s in Watson (on pages 354, referenced on page 5 of the Examiner's Answer, and 458 respectively). However, neither Figure 1 describes corn meal obtained after oil extraction of whole high oil corn. In both of these figures, at least one constituent part, *e.g.*, the germ, is removed from the corn before extraction occurs. Accordingly, neither figure discloses corn meal obtained after oil extraction of whole high oil corn.

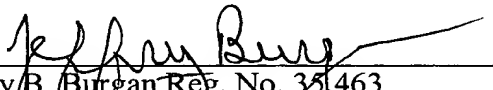
Third, the Examiner impermissibly ignores the steps described in Watson "between the whole corn and the final corn meal prepared." The steps matter not just in respect to the process itself, but also in respect to the resulting product (*e.g.*, corn meal), because the steps affect the type of product obtained. "Corn meal" itself is a generic term. "[C]orn meal obtained after extraction of oil from whole high oil corn" is a specific kind of corn meal. Watson's description of certain specific corn meals, *e.g.*, "corn gluten meal" and "corn germ

meal" in Figure 1 of page 458, does not identify, imply, suggest, or make obvious other kinds of corn meal. Accordingly, the Examiner has failed to make a *prima facie* case of obviousness because of a failure to provide evidentiary support for her conclusion that Watson renders the claims obvious.

Fourth, the Examiner has also failed to make a *prima facie* case of obviousness because of a failure to address with particularity all of the elements of each of the independent claims. There are four independent claims: 1, 16, 17, and 19. For example, claims 16 and 17 specify that the corn meal has various components and amounts thereof. As discussed above, the Examiner in **Remark 9** ("Grounds of Rejection") of her Answer merely restates the language of her rejection from the first Office Action (pages 12-13 of the Action mailed September 22, 2004). While the Examiner does point to various pages from multiple chapters of Watson and Morrison that describe many different corn products with a myriad of characteristics, she does not discuss with adequate specificity where each element of the claims are allegedly described so as to arrive at an embodiment having all the elements of any one of the claims. Accordingly, the Examiner's approach amounts to impermissible hindsight reconstruction.

Morrison does not remedy the deficiencies of Watson. Accordingly, the claims are not obvious over Watson or Morrison, alone or in combination. Applicants submit that the above reasoning establishes that the Examiner's rejections are improper and should be withdrawn and all claims allowed. Applicants respectfully request prompt consideration of this appeal and invite the Examiner and Board to contact the undersigned with any questions.

Respectfully submitted,



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Date: November 23, 2005